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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTOPHE DUPONT,
MARC DAMBRINE, LAURENT SISIAK,
THIERRY BAHAX, STEPHEN MAY, and
STEVEN E. DINGMAN

Appeal 2009-010871
Application 09/833,314
Technology Center 1700

Heard: 15 April 2010
Decided: 22 April 2010

Before BRADLEY R. GARRIS, CHUNG K. PAK, and MARK NAGUMO,
Administrative Patent Judges.

NAGUMO, *Administrative Patent Judge.*

DECISION ON APPEAL

A. Introduction^{1, 2}

Christophe Dupont, Marc Dambrine, Laurent Sisiak, Thierry Bahaux, Stephen May, and Steven E. Dingman (“Nestec”) timely appeal under 35 U.S.C. § 134(a) from the final rejection³ of claims 1-17, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6. We AFFIRM.

The subject matter on appeal relates to a canned pet food having the form of an outer tube packed with an inner core, each including an edible source of carbohydrate and protein, and each region having an appearance different from the other. In certain embodiments, the outer phase is said to be thermally gelled, and in other embodiments, the inner phase is said to comprise chunks of a formulated emulsion product (e.g., simulated meat chunks) in a gravy. The appearance of the food is said to “further stimulate consumer interest.” (Spec. 2.) The identity of the consumer (e.g., the purchaser or the ingester) is not specified.

¹ Application 09/833,314, *Canned Filled Pet Food*, filed 10 April 2001 as a continuation of an application filed 23 February 1999, and as a continuation-in-part of another application claiming the benefit under 35 U.S.C. § 371 of an application filed 17 July 2007, as well as the benefit under 35 U.S.C. § 119(a) of a European application filed 12 March 1998. The specification is referred to as the “314 Specification,” and is cited as “Spec.” The real party in interest is listed as Nestec, S.A. (Appeal Brief, filed 12 June 2007 (“Br.”), 2.)

² The Official Transcript of the hearing held 15 April 2010, which was not available when this Opinion was entered, will be made of record.

³ Office action mailed 20 September 2006 (“Final Rejection”; cited as “FR”).

Representative Claim 1 is reproduced from the Claims Appendix to the Principal Brief on Appeal:

1. A canned pet food product having an upper end and a lower end, the product comprising:

an outer, tubular phase which is
substantially solid and which extends from the lower end to the upper end and which includes an edible source of carbohydrate and proteins; and

a substantially cylindrical inner phase which extends from the lower end to the upper end of the outer phase and including an edible source of carbohydrate and protein;
the inner phase having an appearance different from the outer phase and extending within the outer phase.

(Br., Claims App. i; indentation and paragraphing added.)

The Examiner has maintained the following ground of rejection:⁴

Claims 1-17 stand rejected under 35 U.S.C. § 103(a) in view of the combined teachings of Ohba,⁵ Vickers,⁶

⁴ Examiner's Answer mailed 17 March 2009 ("Ans."), which is said to correct informalities in the Answer mailed 23 October 2007. References relied on by the Examiner for a common or closely related teaching are grouped in parentheses.

⁵ Naoki Ohba et al., *Pet Food Packed in Container*, EP 0769252 A1 (1997).

⁶ Hedley Vickers, *Improvements in the Manufacture of Meat Rolls*, GB 341,760 (1931).

May,⁷ (Gutmann,⁸ Froebel,⁹ Zitin,¹⁰ Dodge¹¹),
(McMahon,¹² Hillebrand,¹³ Errass,¹⁴ QP Corp 677,¹⁵
QP Corp 174,¹⁶ Quaker Oats,¹⁷ Bechtel,¹⁸ Routh,¹⁹
Diaz,²⁰ Hoashi,²¹ Honma,²² and Sonoya²³).

Nestec argues that the number of references applied, the “or vice-versa” language used in the Examiner’s statement of rejection, and the alleged absence of a principal reference make the rejection “difficult to address.” (Br. 12, 2d full para.) Substantively, Nestec argues that the Examiner erred by failing to establish a motivation to combine the

⁷ Stephen May, Steven E. Dingman, and Luz Rayner, *Layered Canned Pet Food*, WO 98/05219 (12 February 1998). (May and Dingman are co-inventors on the present application.)

⁸ H.A. Gutmann, U.S. Patent 2,421,199 (1947).

⁹ Roland Arthur Froebel and Krunoslav Saric, GB 2,194,125 A (1988).

¹⁰ Arnold Zitin, U.S. Patent 2,937,095 (1960).

¹¹ John W. Dodge et al., U.S. Patent 3,385,712 (1965).

¹² Alistair John McMahon, GB 1,583,351 (1981).

¹³ Brigitte Hillebrand and Hans Uwe Trueck, AU-A-50797/96 (1996).

¹⁴ Werner Errass, EP 0,675,046 A1 (1995).

¹⁵ Joki Yamada, JP 59-31677 (1984) (hereafter “QP Corp ‘677”).

¹⁶ Tsuneki Yamada, JP 61-100174 (1986) (hereafter “QP Corp. ‘174”).

¹⁷ Quaker Oats, GB 1,327,351 (1973).

¹⁸ Peter J. Bechtel, U.S. Patent 3,738,847 (1973).

¹⁹ Almond C. Routh, U.S. Patent 2,344,901 (1944).

²⁰ Jacqueline H. Diaz, U.S. Patent 5,518,746 (1996).

²¹ Chikako Hoashi, JP 62-104,566 (1987).

²² Kazuo Honma, JP 59-159758 (1984).

²³ Setsuko Sonoya, JP 57-012987 (1982).

references. (*Id.* at 12-15.) Nestec argues further that the references fail to disclose or suggest all elements of the claimed invention. (*Id.* at 15-18.)

Thus, Nestec has raised three critical issues in this appeal:

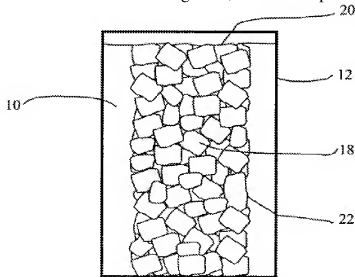
- (1) Is the Examiner's rejection sufficiently clear to be reviewable?
- (2) Did the Examiner err in failing to prove a proper motivation to combine the teachings of the references?
- (3) Did the Examiner fail to show that the references teach or suggest all elements of the claimed invention?

B. Findings of Fact

Findings of fact throughout this Opinion are supported by a preponderance of the evidence of record.

The 314 Specification

1. The invention is illustrated in Figure 4, which is reproduced below:

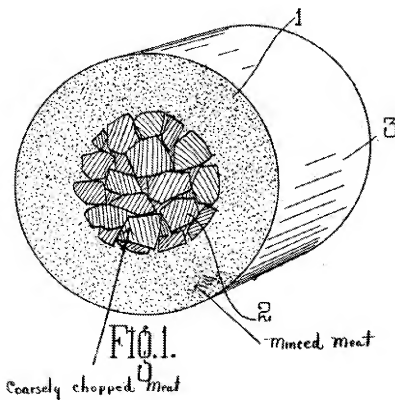


{Figure 4 is said to show a canned pet food}

2. The pet food product is said to comprise an outer tubular phase 12 that is substantially solid; a substantially cylindrical inner phase 18 that extends from the lower end to the upper end of the outer phase 12. (Spec. 2, ll. 9-10, 12-13.)
3. Both phases 12 and 18 are said to comprise an edible source of carbohydrate and protein. (Spec. 2, ll. 10-11, 13.)
4. Inner phase 18 is said to have a different appearance than outer phase 20. (Spec. 2, ll. 13-14.)

Vickers

5. Vickers describes a meat roll, illustrated in Figure 1, which is reproduced below:



{Vickers Figure 1 is said to show a meat roll}

6. The meat roll 3 comprises a shell of minced meat paste 1 surrounding a core of coarsely chopped or sliced meat 2. (Vickers 1, ll. 65-70.)
7. According to Vickers, the term “meat” is to be understood to include “beef or veal, as well as pork, fish,” or the like “with or without added ingredients of animal or vegetable origin such as egg, tomato or the like.” (Vickers 1, ll. 11-16.)
8. Vickers also teaches that the meat paste may be provided with “suitable additions of tomato, bread, spices, flavourings or other ingredients.” (Vickers 1, ll. 100-104.)
9. Vickers teaches further that the coarsely chopped meat may be provided with or without added gelatine, egg, spices, flavourings or other ingredients. (Vickers 1, l. 105-2, l. 3.)

May

10. May describes a layered canned pet food comprising a base layer of solid food pieces in a gravy and having a substantially conical recess formed in its upper surface. (May 2, ll. 13-14.)
11. The upper layer is said to comprise a substantially solid foodstuff that can support the base layer when inverted and that fills the conical recess. (May 2, ll. 16-18.)
12. In May’s words, “[t]he recess into the base layer may extend either partially through the base layer to be conical in shape or entirely through the base layer to be frusto-conical in shape.” (May 2, ll. 26-28.)
13. The solid food pieces comprise protein. (May 2, ll. 30-33.)

14. The gravy comprises starch. (May 2, ll. 35-36.)
15. According to May, “[t]he substantially solid foodstuff is preferably a gelled meat loaf, cooked rice, cooked noodles, or aspic, or mixtures thereof.” (May 3, ll. 10-11.)

Ohba

16. Ohba described canned pet food products comprising two or more types of food prepared from substantially different materials are sorted in the same can. (Ohba, abstract.)
17. Ohba teaches that the foods may be arranged on opposite halves of the can (Ohba, col. 1, ll. 35-40) or in layers (*id.* at col. 1, l. 54-col. 2, l. 1.)
18. According to Ohba, the “substantially different materials” include ingredients such as meat, fish, vegetables, meat extract and various additives. (Ohba, col. 2, ll. 26-31.)

C. Discussion

As the Appellant, Nestec bears the procedural burden of showing harmful error in the Examiner’s rejections. *See, e.g., Shinseki v. Sanders*, 129 S.Ct. 1696, 1706 (2009) (citations omitted) (“Lower court cases make clear that courts have correlated review of ordinary administrative proceedings to appellate review of civil cases in this respect. . . . [T]he party seeking reversal normally must explain why the erroneous ruling caused harm.”) *See also, In re Chapman*, 595 F.3d 1330, 1338 (Fed. Cir. 2010), (discussing the role of harmless error in appeals from decisions of the Board of Patent Appeals and Interferences (“Board”)).

Because Nestec has not argued the limitations of any particular claim as a basis for patentability (Br. 12-18), we consider only claim 1, with which all the remaining claims stand or fall. 37 C.F.R. § 41.37(c)(1)(vii) (setting out requirements for arguing distinct patentability of individual claims and stating that arguments not timely made have been waived: *see also, e.g., In re Hyatt*, 211 F.3d 1367, 1373 (Fed. Cir. 2000) (an argument not first raised in brief to the Board is waived on appeal)).

Is the Examiner's Rejection Reviewable?

Initially, we note that Nestec appears to argue that the Examiner's rejection is too obscure—in particular, that it relies on too many references and that there is no principal reference—and that as a consequence, Nestec has been unfairly compromised in its ability to rebut the rejections.

We do not sit to review the propriety of an Examiner's conduct of the examination. Such matters are petitionable, at levels ranging from discussions of varying formality with the Examiner, with the Supervisory Patent Examiner, or with the Technology Center Director, to a formal petition to the Director of the USPTO under 37 C.F.R. §§ 181-183. The scope of our inquiry in that regard is limited to an assessment of whether the Examiner has set out one or more rejections that are reasonably understandable and thus are amenable to response by Appellants and review by the Board. Should we find no reviewable rejection, we may reverse the

decision of the Examiner or remand the application to the Examiner.
37 C.F.R. § 41.50(a)(1).²⁴

We therefore begin with a review of the Final Rejection, which, since it refers to the previous Office Actions for the rationale of the rejection (FR 2), amounts to a review of the Examiner's rejections in this case. This review will also set the stage for consideration of the issues of motivation and substance.

The Final Rejection refers to previous Office Actions mailed "1/4/05, 2/9/04, 6/3/03, 11/14/02, and 3/30/06" (FR 2, first para.) for the rationale supporting the rejections. We summarize these Office Actions chronologically.

In the first action on the merits ("OA1"),²⁵ the Examiner found that the canned pet food product described by May differs from the claimed canned pet food product in the shape of the outer phase (cylindrical versus frusto-conical). (OA1 2.) The Examiner argued that, in view of numerous other references said to provide "examples of varying cross sectional shapes of phases including tubular outer phases," that the shape would have been an "obvious matter of choice." (*Id.* at 3, ll. 1-4.) The Examiner argued further that the shape of the outer phase would have been an "obvious function of the particular conventional method of forming the two phases" (*id.* at ll. 4-5), citing numerous references said to show "example[s] of packaged multi-phase products wherein the phases assume various patterns" (*id.* at 3,

²⁴ Remands are subject to additional constraints as of 30 March 2010. *See* 75 Fed. Reg. 15689 (2010).

²⁵ Office Action mailed 14 November 2002.

I. 22-4, I. 1). Notably, Ohba is cited and relied on (*id.* at 3, last line), although not as a primary reference.

The Examiner maintained the rejection in the next Office Action (“OA2”),²⁶ adding Gutmann, Froebel, Zitin, Dodge, and notably Vickers—all said to have been cited previously, but not relied on—as evidence that a tubular outer phase and inner core composite food product is “notoriously old.” (OA2 3, II. 1-3.)

The third office action (“OA3”)²⁷ is notable primarily as having been made “final.” The Examiner emphasized that May teaches the textured two-phase canned pet food product, and that “[t]he secondary art is only being relied on to teach that applicants are employing a notoriously conventional geometric configuration for composite food materials.” (OA3 at 3, II. 9-13.)

Following an Appeal Brief,²⁸ the Examiner reconsidered the finality of OA3 and issued another Office Action (“OA4”)²⁹ in which the rejection of record was maintained and several obviousness-type double patenting rejections were entered.

In the next Office Action (“OA5”)³⁰, the Examiner rejected independent claims 1, 2, 9, and certain dependent claims as anticipated by May based on an interpretation of the term “tubular” as reading on the

²⁶ Office Action mailed 3 June, 2003.

²⁷ Office Action mailed 9 February 2004.

²⁸ Appeal Brief filed 10 September 2004.

²⁹ Office Action mailed 4 January 2005.

³⁰ Office Action mailed 30 March 2006.

frustoconical recess that can extend entirely through the “base” layer described in that reference. (OA5 at 3, ll. 1-13.) The statement of the obviousness rejection was modified to rely on “Ohba . . . in view of Vickers . . . and May . . . , or vice versa, i.e., Vickers in view of Ohba . . . and May . . . both further in view of [numerous references].” (OA5 at 4, 3d para.; citations abbreviated.)

The Examiner explained first that Ohba describes a canned pet food having two phases that differ in appearance, each of which includes protein and carbohydrate. The difference between the claimed subject matter and Ohba, in the Examiner’s view, is the stuffed tubular arrangement of the phases recited in the claims. (OA5 at sentence bridging4-5.) The Examiner relied on Vickers as evidence that such a tubular arrangement was known for composite foods, and on May for its teachings that canned pet food products are known “wherein there is an outer phase and an inner phase.” (*Id.* at 5, ll. 1-6.) The Examiner concluded that changing the shape of the composite phases to another conventional composite shape would have been obvious. (*Id.* at ll. 11-13.)

The Examiner then considered Vickers as the primary reference. The Examiner found that Vickers teaches composite foods having different appearances in a tubular form with an inner phase. The Examiner then concluded that it would have been obvious to use conventional pet food phases described by Ohba in a form similar to the one described by Vickers. (OA5 at 6, ll. 8-13.)

The Final Rejection followed, only the rejection on appeal being maintained.

Although at first blush the number of references cited by the Examiner in the statement of the rejection may appear daunting, review of the statements of the rejections through prosecution and in the Examiner's Answer shows that the situation is only superficially complex. First, we note that the Examiner set out express findings regarding Ohba (OA5), Vickers (OA3, OA5), and May (OA1, OA3, OA5). The Examiner also set out reasons explaining why the claimed subject matter would have been obvious starting from either Ohba (OA5 at 5) or Vickers (*id.* at 6). Nestec's protest that the primary references are not identified (Br. 12) is baseless.

Moreover, the thrust of the Examiner's rejections remained clear and relatively constant throughout prosecution. The Examiner argued that the prior art (first May (OA1-OA4), subsequently Ohba (OA5)) shows that it was known to provide canned pet food comprising protein and carbohydrates, in at least two phases having different appearances in a single can, in many different arrangements. The Examiner found further that it was also known (Vickers (OA2-OA5)) to provide meat rolls having the filled tubular geometry and different appearance of the tube and the filling required by the claims. Rather than merely concluding that it would have been an obvious matter of design choice to package, in a can, two differently textured pet foods in the geometry described by Vickers, the Examiner came forward with a host of additional references said to show that it was known to provide different arrangements of different phases of food and other packaged products, according to the physical properties of the materials and the desires of those skilled in the various arts.

Although we caution the Examiner that unreferenced summaries of references may not be credited (*see* the substantive discussion, *infra*), we cannot say that the Examiner's handling of the references was so untidy, obscure, or misleading, that Nestec or the merits panel of the Board have been prevented from being placed in a position to understand and respond to the rejections. We therefore proceed to address the merits of the rejection.

Motivation

Nestec argues that the Examiner failed to establish a motivation to combine the references, and that the references actually teach away from the proposed combination. (Br. 12, 2d full para.)

Our reviewing court has explained that, to “teach away,” a reference must state that it “should not” or “cannot” be used in combinations with the other reference. *Para-Ordnance Mfg., Inc. v. SGS Importers Int’l, Inc.*, 73 F.3d 1085, 1090 (Fed. Cir. 1995). Nestec has not directed our attention to any disclosure in Ohba, Vickers, or May, that indicates that, for example, a meat roll cannot, or should not be formed in a mold that is then sealed, i.e., “canned.” Canned meats and other food products are, after all, well known. Nor has Nestec directed our attention to any disclosure in Ohba or May that indicates that pet foods comprised of protein and carbohydrates cannot, or should not be formed into tubular structures. Nor has Nestec come forward with credible evidence or argument explaining why food products intended for human consumption would not have been considered as models for as canned food intended for consumption by pets.

The Examiner, apparently recognizing that an argument that a modification is “obvious as a matter of choice” requires supporting evidence, came forward with a large number of citations that are urged to provide the requisite support. The Examiner may justly be faulted for not citing specific evidence in these references and explaining why that evidence supports the conclusion that such modifications would have been simple matters of design choice.

Our principal role is review of rejections. We are not charged with scouring the record for evidence that supports the arguments of either the Examiner or of the Appellants. It is the burden of the proponent of a position to come forward with evidence supporting that position, and to explain why the evidence is probative. The Examiner failed to do this for the majority of the secondary references cited in support of the “obvious matter of choice” theory of obviousness. Accordingly, we decline to credit those references and “arguments.”

However, the Examiner did cite Routh as showing that the cross-sectional patterns of multiphase products in containers can be varied. (OA1 at 3, ll. 16-19.) The Examiner continues to rely on Routh (Ans. 5) (unlike Henkel (GB 1,486,634) and Mandanas (WO 94/26606), originally discussed in OA1 at 3, which the Examiner has dropped as “superfluous” (Ans. 4) and which we therefore decline to consider). Nestec’s sole discussion of Routh, however, is that it relates to ice cream products. (Br. 18.) Nestec does not explain why the Examiner’s conclusion that Routh’s description of different cross sections of different phases of an ice cream food product would not have suggested that different cross sections could be produced in other food

products made from other materials, such as the meats, vegetables, and grain products, i.e., mixtures of proteins and carbohydrates, described by Ohba, May, and Vickers.

Moreover, as discussed in detail in the next section, Ohba, and especially May, provide several examples of different arrangements of differently textured canned pet foods that support the Examiner's conclusion that the claimed arrangement of differently textured foods in cans would have been prima facie obviousness. We are not insensitive to Nestec's complaint (Br. 12) that a large number of references can make response difficult. In this case, however, the large number of references were cited cumulatively, and only a few were discussed in detail sufficient for substantive review. Accordingly, we find no merit in Nestec's argument that the Examiner failed to establish a motivation to combine the teachings of the references.

Every Element

Nestec's objection that the combination of references fails to disclose or suggest every element of claim 1 (Br. 15-18) is not well taken.

Nestec begins its arguments regarding motivation (Br. 12) and its arguments regarding the elements of the claims (Br. 15), with a discussion of May. Thus, Nestec characterizes May as being "entirely directed to a canned pet food product having two layers (a base and an upper layer)." (Br. 12, citing May 2, ll. 11-19.) Similarly, according to Nestec, "*May*, fails to disclose or suggest the outer, tubular phase features required by the claimed invention." (Br. 15, last full para.) "Instead," Nestec argues, "*May*

discloses clearly defined upper and base layers such that, after opening the can and dispensing the pet food, what was the base layer becomes the upper layer . . . rather than vertical layering as in the present invention.” (*Id.* at 16, ll. 1-4, citing May 2, ll. 20-25.)

These characterizations are at best incomplete. May, as the Examiner pointed out (OA5 at 3), teaches that the “base” layer contains a “recess.” (May 2, l. 14.) In May’s words, “[t]he recess into the base layer may extend either partially through the base layer to be conical in shape or *entirely through the base layer to be frusto-conical in shape*. The upper layer *may* include an upper portion above and covering the upper surface of the base layer.” (May 2, ll. 26-29; emphasis added.) As indicated by the italicized word “*may*” in the second quoted sentence, May suggests that the upper layer need not include an upper portion above and covering the base layer. Thus, although May may prefer embodiments in which the “upper layer” actually covers the base layer, May does not exclude embodiments in which it does not cover the base layer. We find no merit in Nestec’s arguments to the contrary.

Such embodiments differ geometrically from the meat rolls described by Vickers only in the “frusto-conical” shape of the interior “recess” in May’s food products. Even assuming, arguendo, that the term “substantially cylindrical inner phase,” which appears to be undefined in the 314 Specification, excludes a “frusto-conical” inner phase, we are hard-pressed to see merit in arguments that the modification to the unslanted vertical described for meat rolls would not have been obvious to persons having ordinary skill in the art.

Nestec appears to object further that Vickers relates to meat rolls “rather than canned pet food.” (Br. 18, 3d full para.) But Nestec has not directed our attention to any credible disclosure in the record that a person having ordinary skill in the art would have declined to consider arrangements of food products such as the meat roll described by Vickers when considering arrangements for similarly textured canned pet foods. Vickers, like Ohba and like May, describes two-phase, visually distinct regions in a food product that contains protein and carbohydrates in both phases. Nor is Routh inconsistent with the Examiner’s conclusion that the geometric arrangement of canned foods within the can would have been obvious as a matter of choice. That is, the suggestion that a particular arrangement is possible in one food product would have suggested that arrangement for other food products. Nestec has not come forward with evidence that such arrangements would have been beyond the abilities of those of ordinary skill in the art.

In conclusion, we are not persuaded by Nestec’s arguments that harmful error has been shown in the Examiner’s rejection.

D. Order

We AFFIRM the rejection of claims 1-17 in view of the combined teachings of Ohba, Vickers, May, and Routh.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

Appeal 2009-010871
Application 09/833,314

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K&L GATES LLP
P.O. BOX 1135
CHICAGO, IL 60690